

Remarks

The Applicant recognizes with appreciation the assistance that Examiner Darren Ark provided in the telephone interview of January 13, 2006, as documented in the Interview Summary included with the above-referenced Office Action. In particular, the Applicant wishes to thank Examiner Ark for withdrawing the finality of the Office Action mailed on December 27, 2005, an Action that was replaced by the above-referenced Office Action.

The Applicant respectfully requests entry of the above Amendment, and consideration of the application as amended.

By this Amendment, the Applicant amended claims 1, 16-18, 31, and 36. Cancelled claims 22, 30, 32, and 37 and introduced new claims 39-42. Support for new claims 39-42 appears in Figure 2 of the present application. No new matter was introduced.

Claims 1, 16 -21, 23-25, 27-29, 31, 33-36, and 38-42 are now pending in this application.

1. Response to Rejections Pursuant to 35 USC §103 in view of Marshall and Brott

In paragraphs 2 and 3 on pages 2 and 3 of the Office Action, the Patent Office rejected claims 1, 16, 17, 29, 32, and 34-38 pursuant to 35 U.S.C. 103(a) as obvious in view of the combined teachings U.S. Patent 5,077,931 of Marshall [herein "Marshall"] and U.S. Patent 5,216,830 of Brott [herein "Brott"]. However, the Applicant respectfully submits that this rejection is inappropriate and respectfully requests that the Patent Office reconsider this rejection in view of the following observations and comments.

With respect to claim 1, first, as discussed in the previous response and contrary to the statements made by the Patent Office, the wire-like weedguard 50 of Marshall does not comprise a plurality of spurs as recited in claim 1 and disclosed in the instant application. As clearly illustrated in Figure 2 of the present application and described in

line 11 on page 6 of the application, according to aspects of the invention, the spurs (70) comprise rigid projections from the lip and not simply flimsy wires of "weedguard 50" of Marshall. As disclosed in Marshall, weedguard 50, are not spurs, as understood from the instant specification, but simply wires. Though not described with respect to Figures 7 and 8, Marshall's weedguard 50 is described at 4:20:22 as "wire-like member[s]," not spurs. Moreover, claim 31 recites that the claimed spurs "are adapted to retain one of a second hook and bait." As clearly implied by their use as a bait holder, the claimed spurs comprise at least some rigidity that is not found or suggested by the wire weedguard of Marshall.

Furthermore, though not discussed by Marshall, one of skill in the art would recognize that the function of a "weedguard" is to minimize or prevent entanglement of the lure of Marshall with weeds. Therefore, one of skill in the art would likely avoid any modification or addition to the weedguard of Marshall that would negatively impact this desired function. The Patent Office's suggestion that the weedguard of Marshall be used as bait holders clearly interferes with the intended function of a weedguard. The Applicant submits that mounting bait on the weedguard 50 of Marshall would clearly interfere if not incapacitate the weedguard from performing its intended function. Brott does not address this limitation of Marshall. Thus, the Applicant submits that the invention recited in claim 31 is not obvious in view of Marshall and Brott. Based upon this distinction alone, the Applicant submits that this obviousness rejection of claim 1 based upon Marshall and Brott be reconsidered and withdrawn.

This distinction between the present invention and Marshall is further underscored by the limitations of new dependent claims 39 and 40 where the claimed spurs are recited as "rigid projections" or "spikes." The Applicant submits that the wire weed guard 50 of Marshall are neither rigid nor spikes. Brott does not provide the teachings missing from Marshall.

Second, the Applicant respectfully submits that Marshall does not include a "punched out strap" or any structure that has the structure of the claimed punched out strap as recited in claim 1 and described and shown in the instant specification.

Specifically, claim 1 recites that "the punched out strap having two ends each attached to the lip." The Applicant submits that the claimed strap having two ends is clearly illustrated in Figures 2, 3, 4, 5, and 6 of the instant application, but no such structure appears in Marshall. Clearly, as shown in these figures, for example, strap 30 in Figure 2, this feature of the invention, as claimed, has "two ends each attached to the lip." The Patent Office identifies the strip between hole 22 and edge 20 as a claimed "punched out strap," however, contrary to the strap recited in claim 1, this strip of metal shown in Marshall is neither punched out nor has two ends attached to the lip as claimed. Based upon this distinction alone, the Applicant requests that this obviousness rejection of claim 1 based upon Marshall and Brott be reconsidered and withdrawn.

This distinction between the present invention and Marshall is further underscored by the limitations of new dependent claim 42 where the claimed strap is recited as "elevated with respect to the lip" as illustrated in Figures 2, 3, 4, 5, and 6. The Applicant submits that the strip of lip between hole 22 and edge 20 is in no way elevated with respect to the lip of Marshall.

Third, the Applicant's undersigned Agent typically refers to the MPEP for guidance when considering whether an obviousness rejection under 35 U.S.C. 103 is appropriate. For instance, MPEP § 2143 defines the conditions under which an obviousness rejection is appropriate:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added.]

The Applicant submits that, contrary to the requirements for an appropriate obviousness rejection as outlined in the MPEP, Marshall and Brott do not provide any suggestions of

motivations for combining their teachings to yield the present invention. As discussed below, the Applicant submits that the teachings of Marshall and Brott actually teach away from the proposed combination of their teachings.

In addition, it is well established in the law that it is impermissible to use the Applicant's own disclosure as a basis for formulating a rejection under 35 USC 103. The second paragraph of MPEP 2142 instructs us in this regard.

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. [Emphasis added.]

The Applicant submits that the Patent Office has clearly transgressed this restriction when using the Applicant's present disclosure in formulating the obviousness rejection based upon Marshall and Brott.

The Patent Office admits that Marshall does not teach that the hook be attached to the lip by molded material. The Patent Office relies on the teachings of Brott to provide the teachings missing in Marshall. Specifically, the Patent Office states that it would be obvious to combine the molded lead of Brott. However, the Applicant submits that, as discussed above and throughout this proceeding, one objective of the present invention is to provide an environmentally friendly non-lead fishing device. With that goal in mind, the teachings of Brott - that is, providing molded lead - would not be helpful and would be avoided by one of skill in the art.

Moreover, Marshall clearly teaches away from the use of the teachings of Brott. First, Marshall already attaches the hook 30 by means of screw 40. Why then would Marshall need to a molded lead body to attach its hook? Furthermore, as discussed above, Marshall intends to provide a "lightweight lure," that is, one "designed to ride up over very heavy cover." The use of the heavy lead molding of Brott clearly interferes with that goal. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

## 2. Response to Rejections Pursuant to 35 USC §103 in view of Marshall and Gibbs

In paragraph 6 on pages 4 and 5 of the Office Action, the Patent Office rejected claims 18-25, 27, 28, 30, and 31 pursuant to 35 U.S.C. 103(a) as obvious in view of the combined teachings of Marshall and U.S. Patent 2,700,240 of Gibbs [herein "Gibbs"]. However, the Applicant respectfully submits that claim 18 was amended to introduce the limitation "a plurality of rigid spurs projecting from the body." As discussed above with respect to claim 1, the "weedguard" 50 of Marshall is not rigid and there is no suggestion in Marshall that it be rigid. In addition, Gibbs neither discloses nor suggestions the use of any structures that could be construed as spurs according to aspects of the present invention. The Applicant respectfully requests that the Patent Office reconsider and withdraw these rejections.

## 3. Allowable Subject Matter

Since the limitations of claim 29 were not addressed in the above referenced Office Action, the Applicant assumes that claim 29 recites allowable subject matter. Clarification of the allowability of this subject matter is respectfully requested.

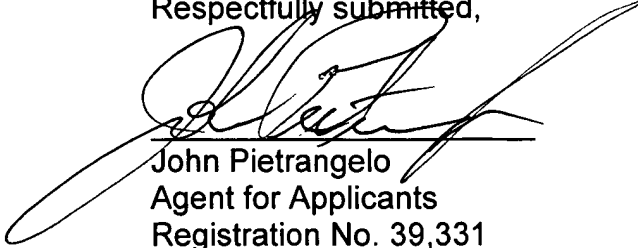
## 4. Conclusions

The Applicant believes that the application is in allowable form. Early passage of the application to issue is earnestly solicited. Should any matters remain outstanding, it is requested that the undersigned Agent be given a call so that such matters may be

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worked out and the application placed in condition for allowance without the necessity of another Action.

Respectfully submitted,



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